

Advisory Action

Application No.

09/904,180

Applicant(s)

ALLEN, KEITH D. #21

Examiner

Daniel M Sullivan

Art Unit

1636

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 24 October 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☐ they raise the issue of new matter (see Note below);
 - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.
- NOTE: See Continuation Sheet.
3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☒ Newly proposed or amended claim(s) 1,2 and 4 would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: _____.

Claim(s) withdrawn from consideration: _____.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____.

Anne-Marie Falk
ANNE-MARIE FALK, PH.D.
PRIMARY EXAMINER

Continuation of 2. NOTE: In the proposed amendment to claim 3, the word "construct" is mistakenly deleted from the first line such that the claim is directed to "a method of producing a targeting", which raises a new ground for objection, or rejection of the claim under 35 U.S.C. §112, second paragraph.

Continuation of 5. does NOT place the application in condition for allowance because: The proposed amendments do not fully address the rejection under 35 U.S.C. §112, first paragraph, of claims 5, 8, 9, 10, 11 and 20-25 as lacking enablement for the full scope of the claimed subject matter. In the remarks that accompany the amendments, Applicant asserts that because the mice and cells of the claims are limited to comprising a homozygous disruption of the stefin homolog gene comprising SEQ ID NO: 1 and exhibiting increased activity or a neuropsychological disorder, the claims are fully enabled by the specification (page 7, fourth full paragraph). However, the previous Office Actions clearly indicate that the specification is enabling only for "a homozygous KNOCKOUT mouse comprising a disruption in the stefin homolog gene comprising the sequences set forth as SEQ ID NO: 1 and exhibiting phenotypic features such as HYPERACTIVITY, DECREASED PROPENSITY TO DESPAIR, SCHIZOPHRENIC BEHAVIOUR AND DECREASED PREPULSE INHIBITION as compared to wild type mice" (Office Action mailed 19 June 2002, paragraph bridging pages 3-4, emphasis added; see also the Office Action mailed 14 January 2003, page 3). In other words, the disruption of the stefin homolog gene must result in loss of expression. In contrast, the proposed claims 5, 8, 9, 10, 11 and 20-25 still encompass a transgenic mouse and cells comprising any disruption (i.e., insertion, deletion or substitution in any portion of the gene; 19 June Office Action, page 5, first full paragraph) and a transgenic mouse that exhibits any neuropsychological disorder. Thus, had the proposed amendments been entered, the scope of claims 5, 8, 9, 10, 11 and 20-25 would still encompass subject matter indicated in previous Office Actions to lack enablement.